

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

App. No.: 10/821,098)	Examiner: Weaver, Sue A.
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Title: COLLAPSIBLE UTILITY BAG AND)	
ADVERTISING VEHICLE)	Art Unit: 3727
)	
Inventor: Bhavnani, Dilip)	
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Filed: 04/07/2004)	
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RESPONSE TO OFFICE ACTION MAILED 08/30/2006

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I. Summary of Office Action

On August 30, 2006, the Examiner mailed a non-final office action in relation to the application identified above. The Examiner objected to the drawings under 37 CFR 1.83(a) for not showing the following claimed features; the shelf, the advertising indicia, and the frame around the front opening. The Examiner further objected to the drawings under 37 CFR 1.84(p)(5) for including the reference character, '150', not mentioned in the description.

The Examiner rejected Claims 1, 4, 5, 7, 9, 10, 25, 27, 28, and 30 under 35 U.S.C. 103(a) as being unpatentable over US Patent No. 5,749,446 issued to Hsieh ("Hsieh reference") in view

of US Patent No. 4,951,818 issued to Johnson (“Johnson reference”). The Examiner also rejected Claims 2, 13, 15, 16, 18, 20, 22, and 23 under 35 U.S.C. 103(a) as being unpatentable over the Hsieh reference in view of the Johnson reference, and further in view of Foreign Patent No. GB 2184940 A issued in UK to Jenks (“Jenks reference”). The Examiner further rejected Claims 3, 8, 14, 21, 26, and 29 under 35 U.S.C. 103(a) as being unpatentable over the Hsieh reference in view of the Johnson reference, Jenks reference, and further in view of US Patent No. 6,244,399 issued to Birkestrand (“Birkestrand reference”). Moreover, the Examiner rejected Claims 6, 12, 17, 24, 31, and 32 under 35 U.S.C. 103(a) as being unpatentable over the Hsieh reference in view of the Johnson reference, Jenks reference, and further in view of US Patent No. 6,132,059 issued to Leibowitz (“Leibowitz reference”). Also, the Examiner rejected Claims 11 and 19 under 35 U.S.C. 103(a) as being unpatentable over the Hsieh reference in view of the Johnson reference, Jenks reference, and further in view of US Patent No. 6,129,254 issued to Yu (“Yu reference”). Lastly, the Examiner rejected Claim 33 under 35 U.S.C. 103(a) as being unpatentable over the Hsieh reference in view of the Johnson reference, Jenks reference, Leibowitz reference, and further in view of US Patent Application No. 2004/0026280 applied by Herold (“Herold reference”).

II. Applicant’s Response

A. Objection to Drawings

Applicant has revised the drawings to show the features at issue, ‘the shelf’, ‘the advertising indicia’, and ‘the frame around the front opening,’ with reference numbers assigned.

Applicant accordingly amended the specification to have those newly shown features in the drawings adequately described and referred to. Applicant respectfully submits that such amendment overcomes the objection under 37 CFR 1.83(a).

Applicant submits that the Examiner's objection under 37 CFR 1.84(p)(5) for failing to describe in the specification the feature represented by the reference character '150' has been raised in error because the challenged feature has been repeatedly and amply described in the specification with referring to the cited reference number. (*See* Specification, pp. 8, lns. 1, 10, 11, 18, 19; *and also*, pp.9, lns. 24-25). As such, Applicant respectfully submits that the stated objection should be withdrawn.

**B. Independent Claims 1 and 7, Dependent Claims 4, 5, 9, 10, 25, 27, 28, and 30
Are Not Obvious over the Hsieh Reference in view of the Johnson Reference.**

The Hsieh reference discloses a collapsible luggage piece having reinforcing top, bottom, and side panels connected to walls. The Johnson reference teaches a box having at least one wall containing a zippered compartment for removably disposing a panel therein. As the Examiner himself found, each of the top, bottom, and side panels disclosed in the Hsieh reference is hingedly connected to a corresponding wall. The motivation cited by the Examiner for modifying the panels of the Hsieh reference to be removably retained against the corresponding wall via, for example, zippered compartments as in Johnson, was "so that [the panels] might be replaced if damaged."

First of all, Applicant submits that even assuming that the two references disclose, as combined, all elements and limitations of independent Claims 1 and 7, those claims should not be deemed obvious because the Examiner failed to meet the burden of establishing the *prima*

facie case of obviousness by finding some teaching, suggestion, or motivation, either explicitly or implicitly in the Hsieh references, in the knowledge generally available to one of ordinary skill in the art, or in the nature of problem to be solved, to modify the side panels of the Hsieh reference, that are hingedly connected to adjacent side walls, to have them removably retained against the side walls as taught in the Johnson reference.

It is well settled that to combine or modify prior art references to produce the claimed invention in establishing a *prima facie* case of obviousness, there must be some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves, the knowledge generally available to one of ordinary skill in the art, or the nature of problem to be solved. *See In re Dembiczak*, 175 F.3d 999, 998, 50 USPQ2d 1614, 1616 (Fed. Cir. 1999); MPEP 2143. The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art. *In re Kotzab*, 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000). To modify a prior art reference to render a patent obvious requires that the prior art suggested the desirability of the modification. *In re Fritch*, 972 F.2d 1260, 23 USPQ2d 1780, 1784 (Fed. Cir. 1992). *See also, In re Gordon*, 733 F.3d 900, 902, 221 USPQ 1125, 1227 (Fed. Cir. 1984) (“The mere fact that the prior art could be so modified would not have made the modification obvious unless the prior art suggested the desirability of the modification.”) Such finding of some suggestion, or motivation to combine or modify references should exist even for simple changes or combinations, *In re Chu*, 66 F.3d 292, 36 USPQ2d 1089 (Fed. Cir. 1995) (“Although a prior art device could have been turned upside down, that did not make the modification obvious unless the prior art fairly suggested the

desirability of turning the device upside down”). Where the incentive to combine the teachings of the references is not readily apparent, it is the duty of the Examiner to explain why the combination of reference teachings is proper. *Ex Parte Skinner*, 2 USPQ 2d. 1788, 1790 (B.P.A.I. 1986).

Applicant respectfully submits that the Examiner failed to meet the burden of establishing *prima facie* case of obviousness because the suggestion or motivation cited by the Examiner is not based on any particular findings in the reference as it should be. The express or implicit showing of such motivation, suggestion, or teaching must be based on particular findings related thereto, and broad conclusory statements standing alone are not evidence. *In re Dembiczak*, 175 F.3d at 999. *See also, In re Fritch*, 972 F.2d at 1783-84 (“The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification.”). The Examiner did not point out any particular part in the Hsieh’s reference, whether in the specification or drawings, to support such motivation of modification cited by him. Nor did the Examiner identify any knowledge generally available to one of ordinary skill in the art, or the nature of problem to be solved so as to implicitly suggest or motivate such modification. As understood by Applicant, nothing in the Hsieh’s reference suggests, whether explicitly or implicitly, any desirability of modifying the panels to be capable of being removably retained for whatever purpose, much less the purpose cited by the Examiner, i.e., future replacement of the panels in case of potential damage. Therefore, Applicant respectfully submits that the Examiner failed to meet the burden of establishing *prima facie* case of obviousness, and on that basis alone, independent Claims 1 and 7 should be rendered non-obvious.

Furthermore, Applicant submits that Claims 1 and 7 should be deemed non-obvious because the Hsieh reference appears to be teaching away from such modification. A reference is deemed “teach away” when “ a person of ordinary skill, upon reading the reference, would be discouraged from following the path set out in the reference, or would be led in a direction divergent from the path that was taken by the applicant.” *In re Gurvey*, 27 F.3d 553, 31 USPQ 2d 1130, 1131 (Fed. Cir. 1994).

Firstly, the only method of connection between the panels and their respective walls ever mentioned or disclosed in Hsieh is ‘pivotal connection.’ (See Hsieh Col. 3, Ins. 14-17 for the side panels; Col. 3, Ins.30-32 for the top panel; and Col. 3, Ins. 36-37 for the bottom panel). No other way of connection is ever mentioned or alluded. Further, such pivotal connection appears to be intended as a non-removable connection, as can be seen from the fact that the means disclosed by Hsieh for implementing such pivotal connection, is ‘stitching’, which is a non-removable means, (See Hsieh Col. 3, In. 16; See also Col. 3, In. 31), and the fact that Hsieh discloses separate means for releaseably attaching the panels to the respective walls, such as the ‘engaging elements 40a’ and ‘mateable engaging elements 40b’ for the side panels, (See Hsieh Col. 3, Ins. 20-21), and the ‘locking elements 44’ and ‘rivets 46’ for the top and bottom panels, (See Hsieh Col. 3, Ins. 32-34), all of which are disposed at an edge of each panel opposite to the edge pivotally connected. Applicant maintains that disclosing only a non-removable hinged connection together with failing to mentioning any other mode of connection in Hsieh should be viewed as implicitly, but specifically, limiting the connection method between the panels and the walls to hinged or pivotal connection.

Secondly, contrary to the Examiner’s assessment, further modification of the panels in

Hsieh to make them removable for protection against potential damage would not be a concern to those skilled in the art who read the Hsieh because Hsieh discloses that some degree of protection against the damage of panels has been already provided thereto. Hsieh discloses that the panels are ‘made out of strong material like a metal or a hard plastic,’ which would provide a considerable structural stability against potential physical damage, and further, that the panels ‘covered with the same material the walls are constructed of,’ which would provide protection against surface damage. (See Hsieh, Col. 4, Ins. 18-25). As understood by Applicant, nothing in the Hsieh reference mentions, recognizes, or even alludes any concern regarding protection of the panels, much less any problem associated with the composing material or covering material of the panels, so as to make it desirable to modify the connection of the panels to the walls to be completely removable in case of potential damage. For this reason, Applicant submits that, one of ordinary skill in the art reading the Hsieh reference would not be motivated of modifying the panels to make it removable from the walls, and especially, not out of the concern about the potential damage to the panels.

Thirdly, one of ordinary skill in the art would be further taught away from modifying the panels to have them removably connected to their respective walls because such modification would be incompatible with the explicitly disclosed methods of collapsing the luggage piece in Hsieh, and so, render the luggage piece, if so modified, unsatisfactory for its intended usage. In its ‘Claims’ and ‘Summary of the Invention’, the Hsieh discloses that ‘wherein in the collapsed configuration, at least a portion of the [first, second, third, or fourth] erecting panel is moved to a position not perpendicular to the rear panel to allow the luggage body to collapse.’ (See Hsieh, Col. 6, Ins. 25-28; Col. 6, Ins. 46-48; Col. 7, Ins. 4-8; Col. 1, Ins. 58-60). In describing how such

a claim limitation is implemented in the specification, Hsieh states that “[when] it is desired to collapse the luggage piece 12, ... each pair of engaging elements 40a, 40b ... are disengaged from one another and the two side erecting panels 38 are pivoted away from the side walls and toward the front panel 30 to a position not perpendicular to the rear panel 28.” (Hsieh, Col. 5, lns. 5-11). Similarly, each of the top panel 42 and bottom panel 48 is also pivoted away from the respective top or bottom wall toward the front panel so that each is not perpendicular to the rear panel 28. (See Hsieh, Col. 5, lns. 22-25; See also Col. 5, lns. 35-38). This is the only mode, that Hsieh discloses, of implementing the claim limitation that ‘each panel is moved to a position not perpendicular to the rear panel.’ No other method is mentioned in Hsieh. Nor is found even a broad statement allowing the possibility of using any other method. As such, Applicant maintains that in Hsieh, ‘pivoting the panels away from the respective wall toward the front panel’ is the very intended way for achieving the claim limitation at issue, and accordingly, the panels and walls being pivotally connected to each other amounts to, in fact, a structural requirement. If the panels in Hsieh are modified to be removably retained against their respective walls, however, the panels would not be able to pivot away from their respective walls, and thus, could not be ‘moved to a position not perpendicular to the rear panel’ in the way intended and defined in Hsieh. Therefore, such modification would render the luggage piece in Hsieh unsatisfactory for its intended usage and way of operation. If proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d at 900. Therefore, Applicant submits that a person of ordinary skill in the art, who reads the Hsieh reference would be in fact discouraged from modifying the panels, in contravention of the

teaching of Hsieh, to have them removably connected with and retained against their respective walls.

For all the reasons stated above, Applicant respectfully submits that independent Claims 1 and 7 should be deemed non-obvious over the Hsieh reference in view of the Johnson reference. For exactly the same reasons, the two independent method claims 25 and 28 which requires respectively the step of ‘inserting a side panel into a side panel retaining means of each side wall’ and ‘removing each of two side panels from a side panel retaining means’ should be deemed non-obvious over the cited references because those steps also require the side panels being removably retained against the side walls. In the respect that independent Claims 1, 7, 25, and 28 are believed to be non-obvious, their dependent Claims 4, 5, 9, 10, 25, 27, 28 and 30 should be deemed non-obvious as well.

C. Dependent Claims 2, 13, 15, 16, 18, 20, 22, and 23 Are Not Obvious over the Hsieh Reference and the Johnson Reference and further in view of the Jenks Reference.

The Jenks reference discloses a collapsible luggage box having a rectangular stiffening frame around the front opening of the box and the lid, which the Hsieh and Johnson references fail to teach.

Firstly, in the respect that independent Claims 1 and 7 are believed to be allowable as shown previously in section **B**, their dependent Claims 2, 13, 15, 16, 18, 20, 22, and 23 are also believed to be allowable.

Secondly, Applicant submits that Claims 2, 13, 15, 16, 18, 20, 22, and 23 should be

deemed non-obvious on a separate ground, that the Examiner failed to meet the burden of establishing the *prima facie* case of obviousness by finding some teaching, suggestion, or motivation, in either the Hsieh reference either explicitly or implicitly, in the knowledge generally available to one of ordinary skill in the art, or in the nature of problem to be solved, to modify the collapsible luggage piece in the Hsieh reference to employ a peripheral rectangular frame, the feature of the Jenks reference and dependent Claims at issue. The Examiner cited, ‘to maintain the shape,’ as the motivation for combining the teaching of the Jenks reference and adopting a rectangular frame for a further reinforcement to the invention of the Hsieh and Johnson references.

The motivation cited by the Examiner, however, is not based on any particular findings in either the Hsieh or Johnson references. The express or implicit showing of such motivation, suggestion, or teaching must be based on particular findings related thereto, and broad conclusory statements standing alone are not evidence. *In re Dembiczak*, 175 F.3d at 999. As the Federal Circuit held, “[t]he mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification.” *In re Fritch*, 972 F.2d at 1783-84. Where the incentive to combine the teachings of the references is not readily apparent, it is the duty of the Examiner to explain why the combination of reference teachings is proper. *Ex Parte Skinner*, 2 USPQ 2d. 1788, 1790 (B.P.A.I. 1986). The Examiner failed to point out any particular part in the references, whether in the specification or drawings, to support the motivation he cited, ‘to maintain the shape.’ Nor did the Examiner identify any knowledge generally available to one of ordinary skill in the art, or the nature of problem to be solved so as to support such motivation.

Secondly, as understood by Applicant, nothing in the Hsieh or Johnson references disclose any desirability or need to provide further reinforcement means ‘for maintaining the shape’ of their inventions. To the contrary, the Hsieh reference discloses that each panel includes “a rigid, platelike rectangular member made out of strong material like a metal or a hard plastic, capable of providing strength to the collapsible wall structure” (emphasis added) (*See* Hsieh, Col. 4, lns. 18-21). It further states that “when the luggage piece 12 is in the erect configuration, each wall ... has an erecting panel rigidly attached and substantially parallel thereto to provide it with dimensional stability.” The cited phrases clearly disclose that each wall of the Hsieh’s luggage piece is already provided with strength and dimensional stability arising from the panel in the erect configuration. Applicant submits that a person of ordinary skill in the art who is reading this explicit disclosure of the Hsieh reference would be discouraged, rather than motivated, from modifying Hsieh’s invention to employ a further reinforcement means, such as a rectangular frame, for maintaining its shape.

Therefore, Applicant respectfully submits that the motivation cited by the Examiner is at best a result of impermissible hindsight construction and cannot be sufficient legal basis to create obviousness under 35 U.S.C. 103(a).

For the reasons stated above, Applicant respectfully submits that dependent Claims 2, 13, 15, 16, 18, 20, 22, and 23 should not be deemed obvious over the cited references.

D. Dependent Claims 3, 8, 14, 21, 26, and 29 Are Not Obvious over the Hsieh Reference, the Johnson Reference, the Jenks Reference and in further view of the Birkestrand Reference.

In the respect that independent Claims 1, 7, 25, and 28 are believed to be allowable, dependent Claims 3, 8, 14, 21, 26, and 29 are also believed to be allowable. Moreover, in the respect that Claims 13 and 20 are believed to be further allowable on a separate ground as discussed in the previous section C, their respective dependent Claims 14 and 21 are further allowable as well on that ground.

E. Dependent Claims 6, 12, 17, 24, 31, and 32 Are Not Obvious over the Hsieh Reference, the Johnson Reference, the Jenks Reference and in further view of the Leibowitz Reference.

In the respect that independent Claims 1 and 7 are believed to be allowable, their dependent Claims 6, 12, 17, and 24 are also believed to be allowable. The independent method Claim 31 which includes all elements of independent Claim 1 is believed to be non-obvious as well inasmuch as independent Claim 1 is deemed non-obvious, and in that respect, its dependent Claim 32 is also believed to be non-obvious. Dependent Claim 17 is believed to be further allowable inasmuch as its intermediate parent Claim 13 is allowable on a separate ground discussed in the previous section C.

F. Dependent Claims 11 and 19 Are Not Obvious over the Hsieh Reference, the Johnson Reference, the Jenks Reference and in further view of the Yu Reference.

In the respect that independent Claim 7 is believed to be allowable, its dependent Claims 11 and 19 are also believed to be allowable. Dependent Claim 19 is believed to be further

allowable inasmuch as its intermediate parent Claim 13 is allowable on a separate ground discussed in the previous section C.

G. Dependent Claim 33 Is Not Obvious over the Hsieh Reference, the Johnson Reference, the Leibowitz Reference and in further view of the Herold Reference.

In the respect that independent Claim 31 believed to be allowable, dependent Claim 33 is also believed to be allowable.

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